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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex Parte* ULRICH HETZER, JAN KEUNECKE,
11 TORSTEN SCHLAAFF, and GEORGE G. GELFER
12

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14 Appeal 2009-003218
15 Application 09/911,811
16 Technology Center 2800
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19 Oral Hearing Held: June 9, 2009
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22 Before JOSEPH F. RUGGIERO, MASHID D. SAADAT, and
23 ROBERT E. NAPPI, *Administrative Patent Judges*.
24

25 ON BEHALF OF THE APPELLANTS:

26 Steven H. Noll, Esquire
27 SCHIFF HARDIN, LLP
28 6600 Sears Tower
29 Chicago, IL 60606
30

31 The above-entitled matter came on for hearing on Tuesday, June 9,
32 2009, commencing at 9:00 a.m., at the U.S. Patent and Trademark Office,
33 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Jack L. Becker,
34 Notary Public.

1 MS. BOBO-ALLEN: Calendar No. 11, Appeal No. 2009-3218. Mr.
2 Noll.

3 JUDGE RUGGIERO: Good morning.

4 MR. NOLL: Good morning. This is the first time I ever started off an
5 appeal hearing with an apology, but I do wish to apologize for taking your
6 time twice on these two related cases. It was my intention originally or my
7 expectation that they would be consolidated, since they are method and
8 apparatus claims, and I expected that we would have one hearing on both,
9 but for reasons I can't explain, the Examiner took a year longer to write his
10 Answer in this case than he did in other one, and that has resulted, as you
11 know, in your making a decision on the method claims that were previously
12 before you in which you affirmed the Examiner.

13 So the question is obviously why shouldn't that be controlling, and
14 why am I even here? And I thought long and hard about that, and there's
15 actually two reasons. The first is the reason we have two separate cases is
16 that the Examiner did impose a restriction requirement, and of course the
17 basis of the restriction requirement is that the claims are patentably distinct
18 or, or represent patentably distinct inventions. So that being the case, that
19 certainly doesn't preclude you from relying on the previous decision as
20 being dispositive for these claims, these apparatus claims, but it doesn't
21 require it either. So I thought it was worthwhile to revisit at least a couple
22 issues.

23 And the other factor was in the decision in the method claims, at the
24 bottom of page 7, there's a footnote that says we make the observation that
25 although Appellants argue the alleged lack of ambient temperature sense

1 condition data in Smith, that's also one of the references in the present
2 appeal, there is no ambient temperature condition recited in independent
3 claim 1. So that caused me to think that at least one basis for the decision on
4 the method claims may have been that the claiming of the sensing of the
5 ambient temperature was not clearly -- expressed clearly enough in those
6 method claims. In contrast to that, I think that is explicitly present in our
7 apparatus claims on appeal that not only claim the sensor but claim the
8 control unit as being programmed to make use of the sensed ambient
9 temperature.

10 As in the previous appeal, previous appeal, however, the, the basic
11 contention or the basic difference of opinion that we have with the Examiner
12 is that we believe the Smith and Kneezel references only provide generalized
13 teachings of concepts that may have been sufficient to sustain the rejection
14 of the method claims, but here where we're claiming an apparatus, we
15 believe there has to be sufficient guidance even in view of the most recent
16 KSR decision to at least provide some algorithmic instruction as to how
17 you're going to use the sensed ambient temperature in combination with
18 these other two determinations that are among the three that are listed in
19 independent claim 1.

20 We believe the Smith references teaches only sensing the temperature
21 of the print head itself and does not disclose exactly how that is used in a
22 warm-up cycle for operating the print head or operating the printer. From
23 our point of view, the Smith reference just has this block with an input
24 where the temperature TS goes in, and you get an output that says warm-up

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1 pulses or warm-up cycle. We don't find any specific disclosure in that
2 reference as to how the print head block temperature is used at all.

3 That being the case, when we turn to the Kneezel reference, which of
4 course we acknowledge discloses teaching ambient temperature, even if a
5 person of ordinary skill had the insight to make use of ambient temperature
6 in the Smith reference, we submit that when such a person turned to the
7 Smith reference, there wouldn't be any guidance on how to use it. It could
8 be equally possible that you would just substitute ambient temperature, as
9 disclosed in Kneezel, for the print head temperature disclosed in Smith. If
10 you did that, then there's no more guidance to be found in the Smith
11 reference than is present with regard to how you use the print head
12 temperature. If you have the further insight to make use of ambient
13 temperature in addition to the sensed temperature, the print head temperature
14 that's disclosed in Smith, then from our point of view, there is even further
15 speculation involved. It's not even clear that the Smith reference would
16 operate or how it would operate if you were -- had more than one
17 temperature as an input.

18 So from our point of view, we don't disagree that the Examiner has
19 correctly identified the individual teachings of Smith and Kneezel, but we
20 believe that the application of those teachings to read such a combination on
21 independent claim 1 that's on appeal is speculation and has been the result of
22 the Examiner being guided by her own specification.

23 So I won't take more of your time, because we have been through this
24 once before already, but I would be glad to respond to any questions.

25 JUDGE NAPPI: Any questions? Anything?

1 JUDGE SAADAT: No questions.

2 JUDGE RUGGIERO: No.

3 JUDGE NAPPI: I don't think we have any questions.

4 MR. NOLL: Thank you.

5 (Whereupon, the hearing concluded at 10:37 a.m. on June 9, 2009.)

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